

Remarks

After amendment, claims 3-9 and 12-24 remain pending in the present application, claims 1-2 and 10-11 having been cancelled previously. Claims 1-2 and 10-11 were cancelled *without prejudice* pursuant to the Examiner's restriction requirement and Applicants' election. The presently pending claims have been amended to address the Examiner's concerns regarding the formalistic nature of the presentation of the claims and in the case of claims 3, 12 and 13 to address the prior art reference Jiang. Applicants previously amended the claims of the instant application with the intention of filing a divisional application directed to the presently cancelled subject matter. This amendment is made to place the present application in condition for allowance by addressing the Examiner's objections and 35 U.S.C. §112 rejections.

Claims 6, 8-9 and 22-24 have been amended to address the formalistic nature of the Examiner's concerns. No new matter has been added by way of this amendment.

The Examiner has rejected the previously filed claims under 35 U.S.C. §112, second paragraph, §102(a) and §103 for the reasons which are set forth in the office action at pages 3-6. For the reasons which are presented in the sections which follow, it is respectfully submitted that the instant application is now in condition for allowance and such action is earnestly solicited.

The 35 U.S.C. §112, Second Paragraph Rejection

The Examiner has rejected claims 6, 8-9 and 12 under 35 U.S.C. §112, second paragraph for the reason which are set forth in the office action on page 3. In particular, the Examiner objects to the term "substituted phenyl" in claims 6 and 8-9. In response, Applicants have amended claims 6 and 8-9 to recite the specific substituents on the substituted phenyl which is referred to in claims 6 and 8-9.

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Regarding the Examiner's rejection of claim 12, Applicants have amended claim 12 to recite R as a specific silyl protecting group as claimed. It is respectfully submitted that the claims are now in compliance with the requirements of 35 U.S.C. §112, second paragraph.

The 35 U.S.C. §102(a) Rejection

The Examiner has rejected claims 3-9 and 12-24 as being anticipated under 35 U.S.C. §102(a) by Evarts, et al., *J. Am. Chem. Soc.*, 2002, 124 pp. 11093-11101 ("Evarts, et al.") for the reasons which are stated in the office action on pages 3-4. In response, Applicants note that Evarts, et al. was published on September 18, 2002, five days *after* the provisional application from which the present application claims priority. The specific compounds which are disclosed by Evarts, et al., were disclosed in the original provisional patent application s.n. 60/410,421, filed September 13, 2002, on page 4-5 and in the claims on page 70. A copy of the abstract of Evarts, et al., evidencing publication on September 28, 2002 is enclosed. Thus, Evarts, et al., having been published several days *after* provisional application s.n. 60/410,421 which discloses the compounds in Evarts, et al., is not prior art to the present invention.¹ Consequently, Evarts, et al. does not anticipate the present invention under 35 U.S.C. §102(a).

The 35 U.S.C. §103 Rejection

The Examiner has rejected claims 3-9 and 12-24 under 35 U.S.C. §103 as being unpatentable over Jiang, et al., *Org. Lett.* Vol. 2, No. 15, 2000, p. 2181-2184 ("Jiang") for the reasons which are stated in the office action on pages 5-6. The Examiner essentially contends that certain of the compounds which are presently claimed are obvious variants over compounds disclosed in Jiang, and for this reason, the presently claimed invention is unpatentable. Applicants respectfully traverse the Examiner's rejection.

¹ In addition, Evarts, et al. is co-authored by three of the co-inventors of the present application, Philip Fuchs, Jerry Evarts and Eduardo Torres. Evarts, et al. is not prior art against the present application in any event. See, M.P.E.P. 715.01(c).

The Examiner cites Jiang for disclosing compounds on page 2182, in table 1, which contain a phenylsulfonyl group and a hydroxyl group in a position beta to the phenylsulfonyl group.

In response, Applicants respectfully have deleted the first compound which is set forth in claim 12 to which the Examiner has raised his rejection and the first two compounds in claim 13 to which the Examiner has raised his rejection. In addition, a single compound has been canceled from claim 3. It is respectfully submitted that Applicants' claim amendments now bring the present application in condition for allowance. Because of Applicants' amendment, it is respectfully submitted that the claims are now in condition for allowance and such action evidencing allowability is respectfully requested.

For the above reasons, Applicants respectfully assert that the claims set forth in the present amendment are now in compliance with 35 U.S.C. Applicants respectfully submit that the present application is now in condition for allowance and such action is earnestly solicited.

Applicant have neither added nor cancelled any claim. No fee is therefore due for the presentation of this amendment. A petition for a one month extension of time is enclosed as is a check in the amount of \$60 for the extension of time and \$255 for a notice of appeal. Small entity status is claimed for the present application.

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Please credit any overpayment or charge any additional fee due to Deposit Account No. 04-0838. Should the Examiner wish to speak with the undersigned attorney in order to advance prosecution of the instant application, he is cordially requested to do so at the below-listed telephone number.

Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

By 

Henry D. Coleman

Reg. No. 32,559

714 Colorado Avenue

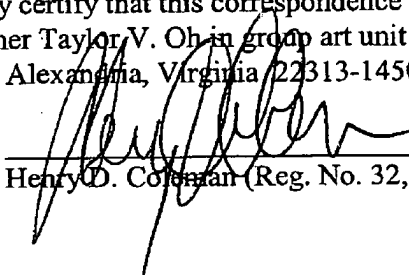
Bridgeport, Connecticut

(203) 366-3560

Dated: September 2, 2008

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I hereby certify that this correspondence is being sent by facsimile transmission to Examiner Taylor V. Oh in group art unit 1625 of the United States Patent and Trademark Office, Alexandria, Virginia 22313-1450, on September 3, 2008.


Henry D. Coleman (Reg. No. 32,559)

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Syntheses of highly substituted enantiopure C6 and...[J Am Chem Soc... http://www.ncbi.nlm.nih.gov/sites/entrez?orig_db=PubMed&db=pu...A service of the U.S. National Library of Medicine
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1: J Am Chem Soc. 2002 Sep 18;124(37):11093-101.

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Syntheses of highly substituted enantiopure C6 and C7 enones(1).

Evarts J, Torres E, Fuchs PL.

Contribution from the Department of Chemistry, Purdue University, West Lafayette, Indiana 47907, USA.

Enantiopure epoxyvinyl sulfones SS-9a, SS-9b, produced from Jacobsen epoxidation of 2-phenylsulfonyl 1,3-cyclohexa- and cycloheptadiene, are used as a template for the construction of substituted cycloalkenones and as chiral synthetic equivalents of enones a and b. The addition of carbon nucleophiles to SS-9a, SS-9b is high yielding and stereospecific. Enantiopure alpha,beta- and gamma-substituted cycloalkenones are easily constructed using a variety of methods.

PMID: 12224957 [PubMed]

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